

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 1794

EXAMINER: Patricia Nordmeyer

In re application of:)
John P. Downs.)
Application No: 10/770,139)
)
Filed: 2/2/2004)
)
Confirmation No.: 9662)
)
Attorney Docket No. 5398-CIP-))
CON-3)

For: THERMOPLASTIC ADHESIVE
DISPENSING METHOD AND
APPARATUS

Customer No. 22922

Commissioner for Patents
Mail Stop Appeal Brief-Patents
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Alexandria, VA 22313-1450

March 25, 2010

Request For Rehearing Under 37 CFR § 41.52

Appellant requests rehearing of the Board's decision stated to have been "Decided" on January 27, 2010¹ of which Appellant was notified of on January 29, 2010.² This request is directed to points believed the Board misapprehended or overlooked. Since this request is being filed on or before March 27, 2010, it is timely.

The Board Misstated The Issue On Appeal

The issue on appeal is not whether Appellant has established "reversible error" on the part of the examiner. Slip op. at 3. Rather, the issue is whether the applied reference

¹ Slip op. at 1.

² PTOL-90A which accompanied the decision as the cover page; "mailed date" per IFW tab on PAIR.

renders the subject matter of any of the claims on appeal as a whole obvious within the meaning of 35 U.S.C. § 103(a). In considering this issue, the Board must keep in mind that Appellant is entitled to a patent unless the PTO establishes reasons to the contrary. 35 U.S.C. § 102 (“A person shall be entitled to a patent unless--...”). Thus, the courts have made it clear that it is the examiner’s initial burden to establish a *prima facie* of unpatentability and if the examiner fails to do so, applicant is entitled to a patent without more. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In phrasing the issue as it did the Board treats the examiner’s position as presumptively correct. Further, phrasing the issue in this manner fosters a piecemeal review of the record and the examiner’s rejection instead of the independent review of the examiner’s adverse decision contemplated by the statute. 35 U.S.C. § 6(b) (“The Board...shall...review adverse decisions of examiners upon applications for patents....”). Such a piecemeal review is not in accordance with the court’s instruction that patentability is determined based upon the totality of the record, taking into account persuasiveness of argument. For example, if the Board treats the examiner’s position as presumptively correct, how can the Board objectively review the record as a whole and objectively assess the persuasiveness of argument?

Further the Board’s citation of *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) and 37 CFR § 41.37(c)(1)(vii), slip op. at 4, do not support the proposition that Appellant “*must* show that the Examiner erred in finally rejecting the claims.” The cited rule only provides for the Argument section in the Appeal Brief and does not stand for the proposition that an appellant must show error. The portion of *Kahn* that is relied upon is a quotation from *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) that indicates the Board is to review the entire position of the examiner, not just those portions that may be alleged to be in error. To put the cited proposition from *Kahn* in proper context, the entire referenced section of *Rouffet* must be considered. That portion reads:

To reject claims in an application under *section 103*, an examiner must show an un rebutted *prima facie* case of obviousness. See *In re Deuel*, 51 F.3d 1552, 1557, 34 U.S.P.Q.2D (BNA) 1210, 1214 (Fed. Cir. 1995). ***In the absence of a proper***

prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant ***can*** overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness. See *id.*

While this court reviews the Board's determination in light of the entire record, an applicant ***may*** specifically challenge an obviousness rejection by showing that the Board reached an incorrect conclusion of obviousness or that the Board based its obviousness determination on incorrect factual predicates.

Id. (emphases added) The use of permissive words such as “can” and “may” show that an appellant is not under the burden alleged in the commentary. Rather the Board must determine patentability based upon the entire record taking into account the arguments that appellant ***may*** make without any presumption of examiner correctness.

As will be developed below, the Board did not consider the record as a whole since the decision overlooks or ignores arguments made by Appellant and relies upon points not made by the examiner in the briefing. It is again urged that when the Board reviews this record using the proper standard, the only reasonable conclusion to be reached is that the examiner failed to carry her initial burden of establishing a *prima facie* case of obviousness. Thus, the rejection should be reversed.

The Board Improperly Shifted The Burden To Appellant

One of the issues on appeal is whether the adhesive segments carried by the tape of Torrey are configured on the tape such that “each of said adhesive segments is individually exposable and dispensable...” as featured in each of the claims on appeal. The examiner dismissed this claim feature as intended use language, stating that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.” Examiner's Answer, page 7. Since the initial burden is always on the examiner to first establish a *prima facie* case of unpatentability, *In re Oetiker*, 977 F.2d 1443, 14445 (Fed. Cir. 1992), it is incumbent upon the examiner to provide a fact-based explanation as to how the tape of Torrey is capable of this claimed function. Obviously, the examiner has

not done so and cannot do so since Torrey is bereft of any specific details of the construction of the described tape. Torrey only provides a broad description of the materials that *may* be used to form that tape and does not provide a specific example of a given tape according to that invention that can be analyzed to determine its functional properties.

Appellant proactively stated his understanding that under certain circumstances the PTO can shift the burden to applicant to provide evidence that that a prior art structure does not necessarily possess a now claimed function. Appeal Brief. Pages 14-15.³ In so doing, Appellant clearly pointed out why such circumstances do not appear in this case. Just as the examiner cannot prove that the tape of Torrey is constructed so that the adhesive segments are “individually exposable and dispensable,” nor can Appellant establish the contrary. As pointed out above and in the briefing, Torrey simply fails to provide sufficient detail as to how that tape is to be constructed. In this regard, it is noted that “it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halbertstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000) (“Under our precedent...it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”) Thus, the Figures of Torrey are of no help in this regard. Thus, Appellant cannot construct a tape according to the teachings of Torrey and test it to determine if it possesses the now claimed function.

Despite the paucity of details in Torrey, the Board stated that “Appellant have not carried their burden to show that the argued functional claim language defines a non-obvious structural feature....”. Slip op. at 12. The Board faults Appellant for not providing “persuasive technical reasoning or even a rationale [sic] basis” for this

³ The Board’s citation of authority on this point at page 5 of its opinion is in accord with Appellant’s understanding of this possibility.

argument. Slip op. at 12. In so holding, the Board ignores the arguments presented by Appellant pointing out the fact that Appellant cannot prove or disprove the functional properties of the Torrey tape as Torrey fails to provide sufficient detail to either discern that tape's capability from its description in the patent or by reasonably requiring Appellant to reconstruct such a tape and test it.

The Board states that in view of "common materials" employed by Appellant and Torrey, the spaced configuration of the adhesive segments of Torrey and the "apparent" flexible nature of the Torrey tape, the Board finds that the argued functional limitation "would have been reasonably expected to be possessed" by the tape of Torrey. Slip op. at 8. The Board takes too broad a view of this issue. The fact that Appellant may broadly make use of some of the materials described by Torrey as being useful in preparing that tape, begs the question—What are the specific materials used in Torrey? Without Torrey describing specific materials useful in making that tape, one cannot reasonably conclude what properties a tape according to Torrey will have. Appellant has done what Torrey has not, provide a description and enabling disclosure of how to arrive at the products featured in the claims where the individual adhesive segments can be individually dispensed.

Further, the Board's conclusion is a *non sequitor* in that the claimed function does not follow merely from the spaced configuration of the adhesive segments on the tape of Torrey. Clearly one needs to know the specific carrier material used, the size and spacing of the adhesive segments, the nature of the specific adhesive used etc. These are all details missing from Torrey.

The consequences of Torrey failing to provide sufficient details to ascertain the properties of that tape should fall on Torrey, not Appellant. By not disclosing sufficient details, Torrey limited its subsequent use as a reference to determine the patentability of patent claims of those that followed such as Appellant. Appellant should not be penalized for the paucity of detail in Torrey.

The Board has placed Appellant under an impossible burden since a tape according to Torrey cannot be produced. To the extent there is a superficial similarity between the tape of Torrey and the tape encompassed by the claims under review, Torrey describes an infinite number of specific tapes that can be manufactured according to the broad directions and lists of materials set forth therein. Under such circumstances, no matter how many tapes Appellant may attempt to reproduce and show that they do not possess the claimed function, the PTO is in a position to sit back and criticize the showing and require more testing.

Another point the Board misapprehended or overlooked in shifting the burden to Appellant is that the purpose of Torrey is to dispense *multiple* segments of adhesive from that tape, not *individual* segments. This point was explained in detail in the briefing. *See, e.g.*, Appeal Brief at pages 12-14. Thus, one would manufacture a tape according to Torrey that performs the function of dispensing multiple segments of adhesive, not individual segments. In similar fashion, if one was to modify the Torrey tape it would do so in such a manner that the modified tape would still dispense multiple adhesive segments.

If the Board continues to shift the burden to Appellant, it is respectfully requested that the Board point to specific embodiments described in Torrey that Appellant should test. Merely observing that the carrier material in Torrey and the present tape may be polyester is not enough as available polyester films have differing thicknesses, compositions and physical properties such as stiffness. Which adhesive should be tested? How big should the adhesive segments be? How should the adhesive segments be positioned and spaced on the carrier material? These are all questions that cannot be answered by reviewing Torrey. By describing the present tape in terms of materials and functions, Appellant have provided an enabling disclosure that describes a product that is non-obvious from the tape of Torrey.

The Board's Reliance Upon *KSR* Is Inapposite

In discussing the *KSR* case the Federal Circuit in *Ortho McNeil Pharmaceuticals, Inc., v. Mylan Laboratories, Inc., et al.*, 520 F.3d 1358, 1364-65 (Fed. Cir 2008), confirmed that “a flexible TSM test *remains* the primary guarantor against a non-statutory hindsight analysis such as occurred in this case (emphasis added).” According to the Court, “[t]he TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of *evidence*—teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)—that arise before the time of invention as the statute requires (again, emphasis added).” *Id.* Thus, any use of common sense in an obviousness determination as posited by the Board, slip op. at pages 10-11, must first be the common sense of a person of ordinary skill in the art at the time the invention was made per 35 U.S.C. § 103(a) and must be supported by evidence. Thus, while invoking so-called common sense, the Board does not explain what facts are relied upon to establish the common sense of the person of ordinary skill in that art at the time of this invention. Invocation of “common sense” does not absolve the Board of relying upon evidence. The lack of evidentiary support for the Board’s invocation of common sense is a powerful indication that it is based upon impermissible hindsight.

Conclusion

Appellant requests that the Board reconsider its decision of January 27, 2010 and reverse the examiner’s rejection. In the alternative, the Board should answer each of the points made above and in so doing specifically explain why it believes Torrey provides sufficient detail so that it is reasonable to shift the burden to Appellant to produce a tape of Torrey and determine its properties. To provide Appellant with procedural due process, the Board should either reverse the rejection of the examiner and make a new

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ground of rejection under 37 CFR § 41.50(b) or denominate its decision on rehearing a new decision under 37 CFR § 41.52(a) and state that Appellant may file a second request for rehearing.

Respectfully submitted:

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